

REMARKS

This Amendment, submitted in response to the Office Action dated December 29, 2003, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1, 2, 4-17 and 19-22 remain pending in the application with claims 6-11 and 13-16 being withdrawn from further consideration.

Claim 4 has been objected to for containing an informality. Applicant has amended claim 4, as set out above.

Claims 2, 12/2 and 17 have been rejected under §112, second paragraph, as being indefinite. Claims 1, 12/1 and 19-22 have been rejected under 35 U.S.C. § 103 as being unpatentable over Takanashi in view of Koguchi (both previously of record).

Claims 5 and 12/5 have been rejected under §103 as being unpatentable over Takanashi in view of Koguchi and further in view of Fujimura (previously of record).

Claims 1, 4, 12/2, 12/4 and 17 have been deemed allowed over the art of record but have been objected to for depending on rejected base claims, and for purported indefiniteness as set forth above. Applicant submits the following comments in traversal of the rejections.

As an initial matter, Applicant would request the finality of the rejection be withdrawn. The recitation regarding the cushion layer now rejected under §112 was previously pending before the Examiner. Therefore, the Examiner had prior opportunity to reject claim 2, 12/2 and 17 on this basis. Rejection on a final basis at this juncture would be prejudicial to Applicant.

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Further, Applicant would submit that contrary to the Examiner's assertions, claims 2, 12/2 and 17 are sufficiently descriptive as Fig. 10 shows a cushion layer 5c in conjunction with an image recording layer 5a. The Examiner's purported reading of an "integral" cushion layer is not supported by the specification or the Figures. Therefore, claims 2, 12/2 and 17 meet all requirements of §112.

With regard to the prior art rejections, the Examiner continues to acknowledge the deficiencies of Takanashi in failing to provide toner sheets in cut sheet form. The Examiner now cites alternative embodiments of Fig. 2 and Fig. 4 to show the purported obviousness of the invention described in claim 1. As an initial matter, the features of different embodiments in Fig. 2 and Fig. 4 cannot be combined, much less interchanged without same basis in the art. No such motivation is evident in this case. In re Kramer, 18 USQP2d 1415, 1416 (Fed. Cir. 1991). It is clear that Koguchi Fig. 2 and Fig. 4 relate to disparate embodiments, including a medium wound about a drum in Fig. 2 and only a tangential recording is shown by Fig. 4. The relative toner sheet thicknesses of the embodiments are not compatible.

Notably, the embodiment of Koguchi Fig. 4 suffers from the same deficiencies of Takanashi alone. The embodiment of Koguchi Fig. 2 remains uncombinable with Takanashi for the reasons of record. In particular, the physical characteristics for securing a roll to the drum differ from that for a cut sheet medium.

The Examiner criticizes prior arguments because the references are discussed individually. However, to the extent individual features were discussed for either reference, this was to highlight basic differences between references that would negate any motivation to

combine. The Examiner has failed to rebut the reasons for non-combinability set forth in the October 15, 2003 Response at page 4, line 3 to page 5, line 5. In other words, these reasons for uncombinability of Takanashi and Koguchi remain of record. In particular, the use of cut sheet forms does not obviate any disadvantages of a roll, the chemical properties of the colorants in Takanashi and Koguchi fundamentally differ such that provision of the donor sheets in Takanashi would not be feasible, and the thinness required of the sheet in Takanashi cannot be adequately smoothed if provided as a cut sheet.

Moreover, even if Koguchi teaches suction for positioning materials against the drum as the Examiner contends, such suctioning would not be appropriate using the wax-binder taught by Takanashi.

Therefore, absent a clear rebuttal of all the arguments of record, Applicant would maintain that independent claim 1 is patentable and the remaining claims are patentable based on their dependency.

With further regard to claim 22, this claim excludes a further image receiving sheet that is required by Koguchi.

In view of the above, Applicant submits that claims 1, 2, 4, 5, 12, 17 and 19-22 are in condition for allowance. Therefore it is respectfully requested that the subject application be passed to issue at the earliest possible time. The Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary.

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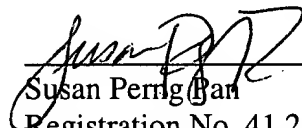
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